

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|--|----------------------------------|---|---|
| In re: | Application No. 10/813,645 |) | <i>Confirmation No. 4942</i> |
| Filed: | March 30, 2004 |) | |
| Applicants: | Randall George KRUEGER et al. |) | |
| Title: | CHEESE WHEEL CUTTER |) | This Application For Patent Term Adjustment was electronically filed on March 27, 2009 using EFS-Web. |
| Art Unit: | 3742 |) | |
| Examiner: | Daniel Leon ROBINSON |) | |
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| Date of Notice Of Allowance, PTOL-85: | January 5, 2009 |) | |
| <hr/> | | | |
| Attorney Docket: | 1410/67404 |) | |
| Customer No.: | 48940 |) | |

Mail Stop ISSUE FEE
Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(b)

Sir:

Reconsideration is respectfully requested of the Patent Term Adjustment that was indicated in the Notice of Allowance to be 1199 days with respect to the above-identified application. Applicants respectfully submit that the Patent Term Adjustment should be 1506 days under 37 C.F.R. §§ 1.703-1.705 and 35 U.S.C. § 154(b) since the initial determination of Patent Term Adjustment improperly overlaps A period delay with B period delay, instead of adding such delays.

Application No. 10/813,645
APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(b) dated March 27, 2009
Notice of Allowance and Fee(s) Due of January 5, 2009

Reference is made to the September 30, 2008 decision of the United States District Court for the District of Columbia in Civil Action No. 07-1494, in the case of *Wyeth et al. v. Jon W. Dudas*, 88 U.S.P.Q.2d (D.D.C. 2008). **In that decision, it was held that the United States Patent and Trademark Office (“USPTO”) practice of granting either the greater of the A period (i.e., delay under 35 U.S.C. § 254(b)(1)(A)) or the B period (i.e., delay under 35 U.S.C. § 254(b)(1)(B)) that would be due a patentee under 35 U.S.C. § 154(b)(1) was not in accordance with the statute, and that there is due to a patentee a term extension in an amount equal to the A period plus the B period, except for any actual overlap between the two periods.** In calculating these two periods, computation of the A period begins at fourteen (14) months following the filing date and calculation of the B period begins at three (3) years following the filing date. We note that the USPTO has since appealed this decision, and that as of this date the appeal has not yet been resolved.

Thus, computing the Patent Term Adjustment consistent with the standard as ruled in *Wyeth v. Dudas*, Applicants respectfully submit that the Patent Term Adjustment should be 1506 days assuming that the patent issues July 14, 2009, which is the Tuesday before the date that is twenty-eight (28) weeks after the mailing date of the Notice of Allowance.

The present application was filed March 30, 2004. As supported by the attached AIPA Term Calculation Report, the A period delay of 37 C.F.R. § 1.703(a), which began on May 31, 2005 and ended on September 10, 2008, is equal to 1199 days (see Row A on page 2). The B period delay of 37 C.F.R. § 1.703(b), which began on March 30, 2007, is equal to 837 days assuming the patent issues July 14, 2009 (see Row B on page 2). The period of actual overlap of the A period delay and the B period delay is 530 days (see page 4). Thus, the non-overlapping portion of the A period delay and the B period delay is 1506 days (see page 4). Applicants have delayed a total of 0 days under 37 C.F.R. § 1.704 (see Row C on page 2, and Rows D and F on page 3). The attached AIPA Term Calculation Report is calculated consistent with the District Court ruling in *Wyeth v. Dudas* (see Row B on page 2). Thus, the Patent Term Adjustment calculated according to the *Wyeth* standard, and which is

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consistent with 35 U.S.C. § 254(b), should be 1506 days (1199 + 837 - 530 days), not 1199 days as stated in the Notice of Allowance (see pages 1 and 4).

This patent application is not subject to a terminal disclaimer.

This Application For Patent Term Adjustment is timely filed, i.e., no later than the payment of the issue fee under 37 C.F.R. § 1.705(b).

According to 37 C.F.R. § 1.705(b)(1), authorization to charge Deposit Account No. 06-1135 for the fee under 37 C.F.R. § 1.18(e) was given using EFS-Web. Because the necessity for filing this request is premised upon the USPTO's calculation of the Patent Term Adjustment in a manner not in accordance with the statute, Applicants respectfully request that this fee be refunded.

The Commissioner is hereby authorized to charge any additional fees which may be required with respect to this communication, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY

Dated: March 27, 2009

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Appendix: AIPA Term Calculation Report

AIPA Term Calculation Report

| APPLICATION INFORMATION | | | |
|-------------------------|--|------------------------|-------------------------------|
| Docket Number: | 1410/67404 | User Name: | Hlebasko, Susan |
| Application Number: | 10/813,645 | Firm/Company Name: | Fitch, Even, Tabin & Flannery |
| Filing Date: | 03/30/2004 | User Comments: | |
| Title/Inventor(s): | CHEESE WHEEL CUTTER; Randall George Krueger , Weyauwega, WI | Calculation Generated: | 03/26/2009 04:44:25 PM ET |

| AIPA TERM CALCULATION SUMMARY | |
|---|---------------------------|
| Earliest Referenced Application under 35 USC § 120, 121, or 365(c): | 03 / 30 / 2004 |
| Filing Date (US National Application): | 03 / 30 / 2004 |
| Net Adjustment Credits: | 1506 Days |
| Net Adjustment Debits: | 0 Days |
| Patent Term Adjustment: | 1506 Days |
| AIPA Patent Term End Date: | 05 / 14 / 2028 (1) |

(1) Assumes payment of all maintenance fees, no intervening acts, and no 35 USC 156 regulatory extensions. Terminal disclaimer(s) filed in this case, if any, may result in an earlier term end date. Without adjustment, the term would end on 03/30/2024.

| COMPARISON TO USPTO PAIR PTA TAB (2) (Based on PAIR Data from 03/26/2009) | | Comparison |
|--|------|------------------|
| | | Your Calculation |
| Credit Days (USPTO Delay): | 1199 | 1506 |
| Debit Days (Applicant Delay): | 0 | 0 |
| Total Patent Term Adjustment Days: | 1199 | 1506 |

(2) Comparison is shown for USPTO Delay, Applicant Delay, and Total Patent Term Adjustments (PTA) tab on 03/26/2009. See the full PAIR PTA tab, file wrapper (e.g., Notice of Allowance, PTA-related petitions), and issued patent for complete information on USPTO-calculated PTA.

| RULE CALCULATION SUMMARY (3) | | | | | | |
|------------------------------|---|--|---------------|--------------------|----------------|-----------------|
| | Event | Rule Invoked | Related Event | Exclusion Days (4) | Debit Days (5) | Credit Days (6) |
| | | 14-Month PTO First Action | | | | |
| A | 03/30/2004 Filing Date under 35 USC 111(a) (US National Application) | PTO must mail a notification under 35 USC 132 or a notice of allowance under 35 USC 151 not later than 14 months after the date on which the application was filed under 35 USC 111(a) or fulfilled the requirements of 35 USC 371 in an international application. Period of adjustment (credits) begins on the day after the date that is 14 months after the date on which the application was filed under 35 USC 111(a) or fulfilled the requirements of 35 USC 371 and ending on the date of mailing of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. 35 USC 154(b)(1)(A)(i); 37 CFR 1.702(a)(1), 1.703(a)(1). | | | | |
| B | 03/30/2004 Filing Date under 35 USC 111(a) (US National Application) | 3-Year PTO Issue of Patent PTO must issue a patent within 3 years (not including exclusions) after the date on which the application was filed under 35 USC 111(a) or the national stage commenced under 35 USC 371(b) or (f) in an international application. Period of adjustment (credits) begins on the day after the date that is 3 years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 USC 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the listed exclusionary periods. 35 USC 154(b)(1)(B); 37 CFR 1.702(b), 1.703(b). You have elected to analyze this rule without applying the USPTO 37 CFR § 1.703(f) Actual Delay limitation in determining Credit Days under this rule. This is consistent with DC District Court ruling in Wyeth et al. v. Dudas, No. 07-1492 (D.D.C. September 30, 2008). | | | | |
| C | 06/15/2004 Notice to File Missing Parts (nonprovisional application) | 3-Month Applicant Response to Notice or Action Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(ii); 37 CFR 1.704(b). | | | | |

First PTO Action:
09/10/2008
Non-final Action

Issue Date:
07/14/2009
Issue Date

0

Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).

You have indicated that no 1.705(c) Showing of Due Care was made.

| | | <u>3-Month Applicant Response to Notice or Action</u> | | |
|--|---|---|---|------|
| D | 09/10/2008 Non-final Action | <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(ii); 37 CFR 1.704(b).</p> <p>Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).</p> <p>You have indicated that no 1.705(c) Showing of Due Care was made.</p> | <i>Applicant Response:</i> 10/10/2008 Reply after Non-final Action under 37 CFR 1.111 | 0 |
| E | 10/10/2008 Reply after Non-final Action under 37 CFR 1.111 | <p>PTO must respond to a reply under 35 USC 132 not later than 4 months after the date on which the reply was filed. The period of adjustment (credit) begins on the day after the date that is 4 months after the date a reply under 37 CFR 1.111 or in compliance with 37 CFR 1.113(c) was filed and ending on the mailing date of either an action under 35 USC 132, or a notice of allowance under 35 USC 151, whichever occurs first. 35 USC 154(b)(1)(A)(ii); 37 CFR 1.702(a)(2), 1.703(a)(2),(3).</p> | <i>PTO Response:</i> 01/05/2009 Notice of Allowance under 35 USC 151 | 0 |
| F | 01/05/2009 Notice of Allowance under 35 USC 151 | <p>Period of adjustment (credits) shall be reduced for the period in excess of 3 months taken to reply to any PTO notice or action making any rejection, objection, argument, or other request, beginning on the day after the date that is 3 months after the date of mailing or transmission of the Office communication and ending on the date the reply was filed. The period, or shortened statutory period, for reply set in the action or notice has no effect on this deadline. 35 USC 154 (b)(2)(C)(ii); 37 CFR 1.704(b).</p> <p>Where applicant shows, in spite of all due care, applicant was unable to respond within the 3-month period, all or part of adjustment may be reinstated for up to 3 additional months. 35 USC 154(b)(3)(C); 37 CFR 1.705(c).</p> <p>You have indicated that no 1.705(c) Showing of Due Care was made.</p> | <i>Applicant Response:</i> 04/05/2009 Issue Fee Payment under 35 USC 151 | 0 |
| G | 04/05/2009 Issue Fee Payment under 35 USC 151 | <p>PTO must issue a patent not later than 4 months after the date on which the issue fee was paid under 35 USC 151 and all outstanding requirements were satisfied. The period of adjustment (credit) begins on the day after the date that is 4 months after the date the issue fee was paid and all outstanding requirements were satisfied and ends on the day the patent issues. 35 USC 154(b)(1)(A)(iv); 37 CFR 1.702(a)(4), 1.703(a)(6).</p> | <i>Issue Date:</i> 07/14/2009 Issue Date | 0 |
| Total Exclusion, Debit, and Credit Days: | | | | 2036 |

| | | | | |
|---|----------|----------|----------|-------------|
| Overlap Days (7) : | 0 | 0 | 0 | 530 |
| Net Exclusion, Debit, and Credit Days: | 0 | 0 | 0 | 1506 |
| Patent Term Adjustment Days (8) : | | | | 1506 |

(3) Calculations of Debit, Credit, and Exclusion Days are determined by the rule assignments, assignments of related events, and analysis options in the Apply Term Rules tab. The patent professional using this system is responsible for reviewing and updating the Apply Term Rules tab to ensure all data is complete, correct, and consistent with their judgment and interpretation of applicable legal authority.

(4) Exclusion Days are periods which are not included in determining the end of the 3-year period after the date on which the application was filed under 35 USC 111(a), or the national stage commenced under 35 USC 371(b) or (f) in an international application, used to determine credits under the 3-Year PTO Issue of Patent rule. See 35 USC 154(h)(1)(B)(i)-(iii); 37 CFR 1.702(b)(1)-(5), 1.703(b)(1)-(4).

(5) Debit Days are days where grounds for reduction of patent term exist. See, e.g., 37 CFR 1.704. Debit Days are sometimes referred to as Applicant Delay.

(6) Credit Days are days where grounds for adjustment of patent term exist. See, e.g., 37 CFR 1.702, 1.703. Credit Days are sometimes referred to as USPTO Delay.

(7) To the extent credit periods overlap other credit periods, debit periods overlap other debit periods, or exclusion periods overlap other exclusion periods, overlaps are subtracted so that each calendar day generates at most one credit day, one debit day, and one exclusion day.

(8) Patent Term Adjustment Days equals Net Credit Days minus Net Debit Days, but is not less than zero.